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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,038	11/23/2005	Matti Lares	043965/291581	5912
826	7590	01/14/2009	EXAMINER	
ALSTON & BIRD LLP			LEONG, NATHAN T	
BANK OF AMERICA PLAZA				
101 SOUTH TRYON STREET, SUITE 4000			ART UNIT	PAPER NUMBER
CHARLOTTE, NC 28280-4000			1792	
			MAIL DATE	DELIVERY MODE
			01/14/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/533,038	LARES, MATTI	
	Examiner	Art Unit	
	NATHAN LEONG	1792	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 14 February 2006.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-14 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>2/14/2006 and 4/28/2005</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-14 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14 of copending Application No. 10/533004, claims 1-11 of copending application 10/533039, and claims 1-13 of copending application 10/533225. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of each copending application overlap in scope with the instant application. In regards to each of the copending applications, ‘039, ‘004, and ‘225 each have a clear overlap in properties and claimed limitations with the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-11 and 13-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 uses the word “precalendering”, which suggests that there is another calendaring process following said precalendering, however none is recited and therefore, the metes and bounds of the instant application are uncertain. Claims 2-11 and 13-14 are likewise rejected as being dependent on claim 1.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eriksson et al US 6022448 in view of Mohan et al US 6287424 and Honkalampi et al US 6164198.

Per claim 1, Mohan teaches a multilayer board, and production thereof, which is heat calendered to improve its surface, see abstract. Mohan teaches the board can be further calendered after the paper is passed through the belted nip so as to control caliper (col. 9, line 38 to col. 10, line 15). Mohan also teaches that the board is usually coated after the calendaring operation (col. 1, lines 16-30). Mohan further teaches that the board can be made of multilayers, including chenmithermo-mechanical pulp and other bleached pulps. Mohan fails to teach all the claimed limitations of the apparatus used in the precalendering process.

Honkalampi teaches using the same device as claimed, and as shown in applicant's specification and figures, in a process of forming a coated boxboard product and the advantages of doing so (see Fig. 1-3 and abstract). It would have been obvious to one of ordinary skill in the art at the time of the invention to have used the apparatus taught by Honkalampi in the precalendering process to form the paperboard articles taught by Mohan. One would have had motivation to make such a modification because Honkalampi teaches advantages of the apparatus such as enabling opening and closing of the nip during operation without the risk of destroying the jacket due to overheating or damaging the flexible jacket, which results in cost savings and less down time; also the tension of flexible jacket in an axial direction may be adjusted in axial

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direction, reducing the wear and tear of the jacket; and produces a paper web which has good stiffness, etc (see col. 2, lines 32-56).

Mohan fails to teach the boxboard product properties as claimed. Eriksson teaches making coated paperboard articles having one, two or more layers coated thereon. Eriksson teaches the outer layer comprising plies formed of bleached sulphate pulp (col. 3, lines 10-14), and teaches other layers may be made of material such as recycled pulp (col. 2, lines 41-47). Per claims 1 and 5-11, Eriksson further teaches in the Examples similar values of density, basis weight (grammage), roughness, and gloss. Additionally, both Eriksson and Mohan teach the claimed properties are recognized as result effective variables. Examiner takes the position that the combination of references, as applied above, would produce a paper with the claimed properties, or one of ordinary skill in the art would be able to arrive and optimize said variables to the desired range to yield the best results via routine experimentation, see MPEP 2144.05. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Mohan by taking into consideration the result effective variables and additional calender treatment of the paperboard of Eriksson because one of ordinary skill would have the desire to produce the best product possible, such as by optimizing the result effective variables taught by Eriksson.

Per claims 2-4 and 14, Mohan teaches that usually the article is coated on one side or if desired, both sides (col. 1, lines 16-30). In addition, the claimed steps of one-sided coating, two-sided coating, two-sided calendering and/or with moistening prior to calendaring (see Mohan abstract) are all well-known and widely practiced by one skilled

in the art. Per claim 12, the paperboard is calendered with a soft extended nip (see Eriksson abstract), providing a board with reduced density and reduced grammage. Per claim 15, it would be obvious to one skilled in the art to only apply the moistening to the side for precalendering if it yields the desired results. Likewise, it is obvious and well within the scope of one of ordinary skill to choose not to apply the moistening to the side, also if desired.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NATHAN LEONG whose telephone number is (571)270-5352. The examiner can normally be reached on Monday to Friday, 7:30am to 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on (571)272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/NATHAN LEONG/
Examiner, Art Unit 1792

/Timothy H Meeks/
Supervisory Patent Examiner, Art Unit 1792